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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/816,012	03/22/2001	Stefan Besling	US018029	5187

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Michael E. Schmitt
Corporate Patent Counsel
U.S. Philips Corporation
580 White Plains Road
Tarrytown, NY 10591

EXAMINER

HESS, DANIEL A

ART UNIT	PAPER NUMBER
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2876

DATE MAILED: 09/13/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/816,012

Applicant(s)

BESLING ET AL.

Examiner

Daniel A Hess

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

2. Claims 1, 2, 5, 6, 9, 13-18 are rejected under 35 U.S.C. 102(e) as being anticipated by Walker et al. (US 6,327,573).

Walker shows a program giving rewards including frequent flyer miles to users of a credit card associated with a particular bank having all of the elements and means as shown in claims 1-6, 9, 17 and 18 drawn to a method and claims 13-16 drawn to an apparatus. For example Walker teaches the following:

Re claims 1 and 17: Walker shows a reward program (column 10, lines 11-15) which attaches rewards to the use of a credit card. When the mass-transportation system is considered to be airline travel, then a credit card and associated account is a transportation pass because it carries and conveys payment for boarding and makes boarding possible for the passenger that carries it. Furthermore, a credit card is typically widely used outside the realm of airline travel. One could certainly use a card at a shop unrelated to transportation, gaining miles toward a flight and then use the same card to pay for the flight (i.e. gain access to the flight).

Re claim 2: A credit card is indeed normally validated electronically.

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Re claims 5 and 6: As a reward for the use of a credit card, the user receives points (column 10, lines 11-15). These points may translate to frequent flyer miles (column 10, lines 19-20). This enables discounts / reduced fair when using air transportation systems.

Re claims 9 and 18: The frequent flyer program is essentially and firstly based on earning miles for flying (hence to the name). In order to compute these miles, customer profiles have to be kept, including information on departures and destinations.

Re claim 13: A credit card can be employed both for gaining access to air transportation systems, and for other non-transportation purposes. See also Pitroda (US 5,590,038) which shows a card explicitly designed (figure 1) to be used both in travel and as a credit card.

Re claims 14 and 15: A credit card transaction is normally preceded by validation, whether used in purchasing airline tickets or used elsewhere.

Re claim 16: As a reward for the use of a credit card, the user receives points (column 10, lines 11-15). These points may translate to frequent flyer miles (column 10, lines 19-20). This enables discounts / reduced fair when using air transportation systems.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various

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claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Walker. The teachings of Walker have been discussed above.

Walker fails to show that a transaction comprises modifying an amount of electronic money, because a credit card balance does not stand for money itself but rather a payable debt.

However, it is widely known in the art that credit and debit cards are art-recognized equivalent forms of payment. Debit transactions do represent a real change in amount of electronic money.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to substitute the old and well-known debit form of payment for the credit payment system of Walker because some customers are credit averse, for fear of landing in debt.

6. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Walker in view of Cucinotta et al. (US 5,663,546). The teachings of Walker have been discussed above.

Walker fails to show that rewards are based on and focused at a particular geographic location.

Cucinotta shows a transaction card (column 2, lines 50-60) whose use can be limited (column 5, lines 58-65) to a particular area.

In view of Cucinotta's teaching, it would have been obvious to one of ordinary skill in the art at the time the invention was made to include the old and well-known limitation of functionality to a particular geographic location as taught by Cucinotta into the credit-rewards program of Walker because Walker is aiming to reward customers for transactions (column 2, lines 13-18) and rewarding transactions in a particular area can boost tourism in that area.

7. Claims 7 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walker in view of Kalina (US 6,243,688). The teachings of Walker have been discussed above.

Walker fails to show or suggest that the frequent flyer programs expire or have a certain associated time frame.

Kalina shows (column 1, line 32) that frequent flyer programs are known to expire.

In view of Kalina's teaching, it would have been obvious to one of ordinary skill in the art at the time the invention was made to include the old and well-known expiring frequent flyer miles because economic conditions may change such that airline promotions are no longer needed to boost air travel. Note that even though, as Kalina notes, expirations may be unpopular for the customer, expirations may be popular with the airlines.

8. Claims 10-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walker, in view of Pitroda (US 5,590,038). The teachings of Walker have been discussed above.

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Re claim 10: Walker shows a reward program (column 10, lines 11-15) which attaches rewards to the use of a credit card. When the mass-transportation system is considered to be airline travel, then a credit card and associated account is a transportation pass because it carries and conveys payment for boarding and makes boarding possible for the passenger that carries it. Furthermore, a credit card is typically widely used outside the realm of airline travel.

Walker fails to specifically state that his system employs electronic cards.

Pitroda shows (column 2, lines 44-45) the use of electronic cards for performing a variety of functions (see figure 1).

In view of Pitroda's teaching, it would have been obvious to one of ordinary skill in the art at the time the invention was made to include the old and well-known electronic cards as taught by Pitroda in the teachings of Walker because such cards can have significant memory to store much of the reward data locally on the card.

Re claim 11: A credit card is indeed normally validated electronically.

Re claim 12: Walker fails to show that a transaction comprises modifying an amount of electronic money, because a credit card balance does not stand for money itself but rather a payable debt.

However, it is widely known in the art that credit and debit cards are art-recognized equivalent forms of payment. Debit transactions do represent a real change in amount of electronic money.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to substitute the old and well-known debit form of payment for the credit payment system of Walker because some customers are credit averse, for fear of landing in debt.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Kogen et al. (EP 1 039 403 A2) employs a smart card in a system of rewards for card use. Sehr (US 6,085,976) shows multi-application transit cards. Also, the examiner wishes to point out that numerous instances of frequent flyer mile-earning credit cards can be found which were known in the art for several years.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel A Hess whose telephone number is (703) 305-3841. The examiner can normally be reached on 8:00 AM - 5:00 PM M-F.

11. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G Lee can be reached on (703) 305-3503. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-7722 for regular communications and (703) 308-7722 for After Final communications.

12. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.



DH

September 9, 2002

Daniel A Hess
Examiner
Art Unit 2876



KARL D. FRECH
PRIMARY EXAMINER